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FEB 22 1987

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: David B. Anderson, et al.)
Serial No.: 811,059)
Filed : December 19, 1985) Group Art Unit: 125
For : GROWTH PROMOTION) Examiner: F. Waddell
Docket No.: X-5683B)

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. 1.116

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Sir:

In response to a final rejection issued in the captioned case on January 13, 1987 (Paper No. 8), Applicants cancelled the only rejected claim (23) and replaced it with a new claim (40), thereby overcoming the rejection. Allowed Claims 12, 35 and 36 were maintained. Applicants added five new claims (37, 38, 39, 41 and 42) directed to subgeneric species. By an Advisory Action dated February 4, 1987 (Paper No. 11), the Examiner refused to enter the amendments, saying they present additional claims without cancelling a corresponding number of finally rejected claims. Applicants courteously request reconsideration and urge entry of the amendments and passage of the case to issue.

The allowed Claims 35, 36 and 12, are directed, respectively, to a method for promoting growth in ruminants comprising administering a specific phenethanolamine (compound 31537) (or an acid addition salt thereof), a method of improving feed efficiency in ruminants using the same compound, and a method of promoting growth in ruminants using the hydrochloride

salt of 31537. The specific compound 31537 required by the allowed claims is a phenethanolamine having two optical centers, and accordingly is comprised of four optical isomers.

The only claim that was rejected by Paper No. 8 was 23, which was a method for improving leanness in animals comprising administering any of a group of compounds, one of which is 31537, or a salt thereof. Applicants cancelled Claim 23 in favor of new Claim 40 which recited a method for improving leanness using the specific compound 31537, or an acid addition salt thereof.

The other additional claims, 37, 38, 39, 41 and 42, are directed to subject matter which is subgeneric to the allowed Claims 35, 36, and what is believed allowable 40. Namely, Claims 35, 36 and 40 claim methods using a specific compound 31537, or a salt thereof. New Claims 38 and 41 are directed to the use of a specific acid addition salt (the hydrochloride) of 31537. New Claims 37, 39 and 42 are directed to the use of a specific optical isomer of 31537. Accordingly, all of the newly added claims, except Claim 40, are subgeneric species to the allowed claims. They are therefore more narrow in scope than the allowed claims. They do not touch the merits of the case. Since the allowed claims already have been held patentable, the more narrow subgeneric species claims are necessarily patentable. The total number of claims offered in the case, as amended, is only nine. The subgeneric claims directed to the pure optical isomers were not earlier added because the data upon which those claims are based was only recently generated. Indeed, the data are submitted in the present case by way of a copy of a declaration that was

submitted in a companion case on December 24, 1986, only two weeks before the final rejection was mailed in the instant case.

Applicants submit that entry of the proposed claims will not result in undue burden upon the Examiner, since the issues involved are so narrow and straightforward, and the patentability of the subject matter is believed already established.

Refusal to enter the amendments may result in unnecessary proliferation of paper, waste of time, and needless extension of patent protection for an invention that has already been found patentable.

In light of the foregoing, Applicants courteously request reconsideration of the decision not to enter the proposed amendments. Applicants believe the interests of everyone -- the Patent and Trademark Office, the Examiner, Applicants and the public -- can be best served by entering the amendments, passing the case to issue, and publishing a patent containing the nine claims now requested.

Respectfully submitted,



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Feb. 13, 1987